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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,351	02/24/2004	Elizabeth Kornecki	19658Z	8733
<div>7590 02/13/2009</div> <div>Peter I. Bernstein Scully, Scott, Murphy & Presser, P.C. Suite 300 400 Garden City Plaza Garden City, NY 11530</div>				
EXAMINER				
WANG, CHANG YU				
ART UNIT		PAPER NUMBER		
1649				
MAIL DATE		DELIVERY MODE		
02/13/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/785,351

Applicant(s)

KORNECKI ET AL.

Examiner

Chang-Yu Wang

Art Unit

1649

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION
RESPONSE TO AMENDMENT

Status of Application/Amendments/claims

1. Applicant's amendment filed 11/18/08 is acknowledged. Claims 1-17 and 19-20 are cancelled. Claim 21 is amended. Claim 22 is newly added. Claims 18, 21 and newly added claim 22 are pending in this application and under examination in this office action.
2. Any objection or rejection of record, which is not expressly repeated in this action has been overcome by Applicant's response.
3. Applicant's arguments filed on 11/18/08 have been fully considered but they are not deemed to be persuasive for the reasons set forth below.

Claim Rejections/Objections Maintained

In view of the amendment filed on 11/18/08, the following rejections are maintained.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by GenBank accession number AA101561, October 1996. The rejection is maintained for the reasons made of record.

On p. 3 of the response, Applicant argues that independent claim 18 was amended to require the claimed oligomer be capable of hybridizing in full-length as well as under high stringency. Applicant argues that AA101561 does not meet all of the limitations of claim 18 because hybridizing AA101561 to SEQ ID NO:1 results in an unhybridized portion of 36 bases on the 5' end of AA101561. Applicant argues that claim 21 has been amended to recite "consisting of". Applicant's arguments have been fully considered but it is not persuasive.

In contrast, the DNA molecule with the GenBank accession no. AA101561 meets the limitation of the DNA oligomer recited in amended claims 18, 21 and 22. First, the DNA oligomers recited in instant claims 18, 21 and 22 are not limited to a particular size, which can be any length or size as long as they can hybridize to a nucleotide sequence of SEQ ID NO:1, nucleotides 16-912 or 97-912 of SEQ ID NO:1. In addition, the recitation "a DNA oligomer capable of hybridizing in full-length under high stringency conditions to a DNA molecule having or consisting of a nucleic acid sequence selected from the group consisting of SEQ ID NO:1, nucleotides 16-912 or nucleotides of 97-912 of SEQ ID NO:1" encompasses any fragments with different lengths derived from the sequence of SEQ ID NO:1, nucleotides 16-912 or 97-912 of SEQ ID NO:1. Thus, a DNA with a short sequence derived from SEQ ID NO:1, nucleotides 16-912 or 97-912 of SEQ

ID NO:1 can hybridize in full-length to any fragments derived from SEQ ID NO:1, nucleotides 16-912 or 97-912 of SEQ ID NO:1.

The DNA molecule of AA101561 is 99.2% identical to the sequence of instant SEQ ID NO:2 of the instant application over a region of 377 bases and the +SEQ ID NO:2 is 74.5% identical to the whole molecule of instant SEQ ID NO:1 as recited in instant claims and with 99.1% local similarity. Thus, the DNA fragment (oligomers) of AA101561 can hybridize to a DNA molecule having or consisting of a nucleotide sequence (fragments) of SEQ ID NO:1, nucleotides 16-912 or 97-912 of SEQ ID NO:1 with high stringency conditions as recited in instant claims 18, 21 and 22.

Accordingly, the rejection of claims 18, 21 and 22 under 35 U.S.C. 102(b) for being anticipated by GenBank accession number AA101561 (October 1996) is maintained.

Conclusion

5. NO CLAIM IS ALLOWED.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Papers relating to this application may be submitted to Technology Center 1600, Group 1649 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chang-Yu Wang whose telephone number is (571) 272-4521. The examiner can normally be reached on Monday-Thursday from 8:30 AM to 6:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Stucker, can be reached at (571) 272-0911.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/CYW/
Chang-Yu Wang, Ph.D.
February 05, 2009

/Christine J Saoud/
Primary Examiner, Art Unit 1647